



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/629,713

07/30/2003

Susan E. Wrenn

021238-610

5365

Peter K. Skiff

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404

Alexandria, VA 22313-1404

7590

06/29/2007

EXAMINER

FELTON, MICHAEL J

ART UNIT

PAPER NUMBER

1731

MAIL DATE

DELIVERY MODE

06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/629,713	Applicant(s) WRENN ET AL.	
	Examiner Michael J. Felton	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-59 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 38-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I in the reply filed on 4/06/2007 is acknowledged. The traversal is on the ground(s) that all groups depend on the elected group. This is not found persuasive because the groups, regardless of dependency are distinct inventions found in different classifications.

2. Claim 28, was mistakenly left out of the restriction requirement, but as it is a method, and distinct from the elected apparatus, it will be withdrawn with the other non-elected groups.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 28, 38-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/06/2007.

Specification

4. The abstract of the disclosure is objected to because it does not discuss the invention that is claimed. Correction is required. See MPEP § 608.01(b).

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Apparatus for linking cigarette making and tipping apparatuses.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the drum link-up assembly connecting to both the combining machine and the tipping machine as described in the specification (only connection to the tipping machine is shown). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 34 recites the limitation "the laser drum" in line 8. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 35 recites the limitation "the combining machine" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art. The applicant admits the following prior art: that tobacco plugs are constructed on a conventional cigarette making machine (page 37, lines 3-4), other suitable plug delivery systems might be employed such as mass flow conveyors or pneumatic tubes or the like (page 37, lines 12-13), garniture operation can be controlled by a double-action plug-tube combiner (page 37, lines 15-20, 25-28), any conventional tipping machine can be used (page 41, lines 9-15), any perforating system can be used (page 44, lines 25-28) including a commercially available Hauni 500 (page 45, lines 1-7). It is assumed that the applicant is intending to claim an apparatus to connect a cigarette making machine and a tipping machine (see 112 rejections).

Although a prior art means for connecting a cigarette making machine and a tipping machine is not disclosed, it would have been obvious to one of ordinary skill in the art at the time of invention to combine both machines, since it has been held that

Art Unit: 1731

forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The admitted prior art also does not disclose a laser perforation apparatus in the connecting means between a cigarette maker and a tipping machine. However, laser perforation apparatus' are well known in the art. In addition, it would have been obvious to include a laser perforation apparatus, which are known in the prior art, at any point along the cigarette making process, including in a connecting means between a cigarette making machine and a tipping machine. It would have been obvious to one of ordinary skill in the art at the time of invention to use a laser perforation system at any point during the manufacture and handling of cigarettes and their components, including the handling of cigarettes between the cigarette maker and the tipping machine, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

14. Claims 29, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dearsley (US 3,036,581) in view of the applicants admitted prior art. The applicant discusses prior art apparatuses such as a conventional cigarette making machine (page 37, lines 3-4), plug delivery systems such as mass flow conveyors or pneumatic tubes or the like (page 37, lines 12-13), garniture operations that are controlled by a double-action plug-tube combiner (page 37, lines 15-20, 25-28), and conventional tipping machines (page 41, lines 9-15), perforating systems (page 44, lines 25-28) including a commercially available Hauni 500 (page 45, lines 1-7). It is assumed

Art Unit: 1731

that the applicant is intending to claim an apparatus to connect a cigarette making machine and a tipping machine (see 112 rejections).

Although the applicant discloses that all the components are commercially known, prior art for using a drum to connect two different cigarette machines is not disclosed. However, Dearsley discloses an attachment for a cigarette-making machine that takes discharged cigarette rods and, using a conveying drum, cutting them and then further processing the rods by applying tipping material, thereby connecting the cigarette machine and the tipping apparatus. It would have been obvious to incorporate the disclosure of Dearsley with the disclosed commercially available cigarette making machine and tipping machine disclosed by the applicant because they are analogous art and solve the same problem. The motivation to do so would be to integrate two devices which would result in time and efficiency savings, as well as reduced damage to cigarettes.

15. Claims 30, 31, 32, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dearsley (US 3,036,581), the applicant's prior art, and in further view of Nichols et al. (US 4,570,649). The applicant discloses that a commercially available laser system, that Hauni 500, is used to perforate the cigarettes, however, it is not disclosed what is part of this system and what is the applicants invention. If the laser system only provides laser radiation, then optics and a beam splitter are needed. Dearsley defines the link-up assembly, including a drum with flutes (col. 13, line 5-10), but not laser perforation.

However, Nichols et al. disclose the use of a laser system, beam splitter, and optics to cut two rows of perforations simultaneously into a tobacco rod or cigarette (col. 4, 19-36). It would have been obvious to one of ordinary skill in the art at the time of invention to perforate tobacco rods and/or cigarettes with a laser, such as that disclosed by Nichols et al. The motivation to include laser perforation would have been to produce a perforated product (with different smoking characteristics) as disclosed by Nichols et al. In addition, the lenses of Nichols et al. are capable of burning rows of perforations, as one of skill in the art would know.

16. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dearsley (US 3,036,581), the applicant's admitted prior art, and Nichols et al. (US 4,570,649). The link-up assembly of Dearsley defines a drum with flutes, but Dearsley does not disclose using several specific drums (laser drum, catch drum, separating drum, cutting drum, and swash drum), nor a laser perforation system. Nichols et al. disclose a laser perforation system that would be obvious to combine with Dearsley (see rejection of claims 30-33).

Neither Dearsley, nor Nichols et al., disclose the multiple drums of the instant application. However, the applicant provides prior art (a portion of fig 9) that discloses the use of these drums in a commercially available system. Elements 238, 250, 260, 261, and 262 show an assembly drum, a swash plate drum, a roll drum, an optional perforation drum, and a cut drum respectively. It would have been obvious to one of ordinary skill in the art at the time of invention to duplicate the parts of the commercial system (admitted prior art) and combine them with the inventions of Dearsley and

Art Unit: 1731


Nichols et al., since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The motivation to do so would be to perforate different wrappers and work with different arrangements of cigarette assemblies to increase throughput.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Felton whose telephone number is 571-272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


STEVEN P. GRIFFIN
PRIMARY EXAMINER

Application/Control Number: 10/629,713
Art Unit: 1731

Page 10

MJF